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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,843	11/04/2003	Robert P. Serravalle	RS-2-gw	7057
7590	07/30/2004			
Michael I. Kroll 171 Stillwell Lane Syosset, NY 11791				
EXAMINER				
RICHARDSON, JOHN A				
ART UNIT		PAPER NUMBER		
3641				

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,843

Applicant(s)

SERRAVALLE, ROBERT P.

Examiner

John Richardson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 8 and 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Non Final Rejection

1). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3). The disclosure is objected to because of the following informalities:

- Figure 1, denotes an **item 2**, that is not disclosed in the specification.

Appropriate correction is required.

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4). Claims 1 to 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Houde-Walter (U.S. 4,934,086).

The applicant's claims are for an apparatus per se and it is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from prior art apparatus" if the prior art teaches all the structural limitations of the claim. In re Masham, 2 USPQ2d 1647.

In addition, claims directed to apparatus must be distinguished from prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device *is*, not what a device *does*. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP§ 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

The reference discloses an apparatus for a firearm handgun (item 10) with a front end and rear end a handle and barrel (Figures 1, 2), comprising a light source (item 20) in the form of light emitting diode or in the alternative infrared light (Column 2, lines 54+), a housing (item 15) disposed in said front end barrel structure (item 11) with opposing front and rear ends (see Figure 3), the said light source disposed in the front end of the said housing (item 17), a means of activating the said light source by positioning a mercury filled gravity switch (item 35) in the handle of the said firearm (see Figures, 1, 2), a power supply for operating the said apparatus (item 30) through an operating circuit (item 31) with an on / off switch (item 33), relating to claim 2, the reference

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discloses a lens detail (item 21), relating to claims 3-4, the reference discloses light emitting diode and infrared light sources (Column 2, lines 54+), relating to claim 5, the reference discloses an end cap feature (item 27) at the rear end of the said housing, relating to claim 6, the reference discloses a battery power source (item 30), relating to claim 7, the reference discloses a mercury switch (item 35) activated by positioning the said handgun (Column 3, lines 40-63).

5). Claims 9 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houde-Walter (U.S. 4,934,086) as applied to claims 1-7 in view of Podvin (U.S. 6,385,894).

The primary reference has been discussed in 3) above and reads on the cited claims except for disclosing specific operating activation signals through a transmitter and receiver components. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated a transmitter and receiver means for activating the Houde-Walter apparatus, since the examiner takes Official Notice of the equivalence of the Houde-Walter activation switch (item 33) and the Podvin transmitter (item 22) and receiver means (item 24) for their use in the firearm art and the selection of any of these known equivalents to activate an electric circuit would be within the level of ordinary skill in the art.

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As discussed in item 3) above the primary reference discloses structures that read on cited claims 10-14.

6). Claims 8, 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7). The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8). Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Richardson whose telephone number is (703) 305 0764. The examiner can normally be reached on Monday to Thursday from 7.00 AM to 4.30 PM. The examiner can also be reached on alternate Fridays.

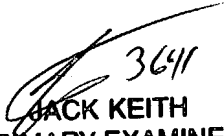
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306 4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305 7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 1113.

John Richardson, PE,

July 27 2004.


JACK KEITH
PRIMARY EXAMINER